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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/977,138	10/12/2001	Wayne Odom	ODOM01-01	2406

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EXAMINER

MARKS, CHRISTINA M

ART UNIT	PAPER NUMBER
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3713

DATE MAILED: 04/08/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/977,138	Applicant(s) ODOM ET AL. <i>MT</i>	
	Examiner C. Marks	Art Unit 3713	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 October 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-36 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input checked="" type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>4</u> . | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Priority

The application states in the specification that it is a CIP of provisional application 60/241,644. The Examiner has corrected the priority claim to read that the application claims benefit of the provisional as an application claiming the benefit of a provisional application under 35 U.S.C. 119(e) should not be called a "continuation-in-part" of the provisional application since an application that claims benefit of a provisional application is a nonprovisional application of a provisional application, not a continuation, division, or continuation-in-part of the provisional application (MPEP § 201.08).

Double Patenting

Claims 1-36 (the '138 claims) provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-11, 13, 19-23, 14-15, 24-25, and 28-36 of copending Application No. 10/121,884 (the '884 claims). Although the conflicting claims are not identical, they are not patentably distinct from each other for the reasons outlined below.

Claim 1 ('138) is obvious over claim 1 ('884) as it would be obvious to not randomize the cards prior to insertion into the data structure.

Claim 1 ('138) is obvious over claim 11 ('884) as claim 11 adds the step of randomizing the cards into a serial order already present in claim 1.

Claim 1 ('138) is obvious over claim 13 ('884) as claim 13 adds the step of displaying each card and then depleting the card from the inventory that is already present in step one.

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Claim 2 ('138) is obvious over claim 2 ('884) as both claims add the step of displaying the constituency at the completion of each hand of play.

Claim 3 ('138) is obvious over claim 3 ('884) as both claims add the step of displaying the constituency after the selection and display of the card.

5 Claim 4 ('138) is obvious over claim 4 ('884) as both claims add the step of reconstituting at a predetermined point in the count.

Claim 5 ('138) is obvious over claim 5 ('884) as both claims add the step of allowing the player to call for reconstitution.

10 Claim 6 ('138) is obvious over claim 6 ('884) as both claims add the step of displaying the deck constituency in a table.

Claim 7 ('138) is obvious over claim 7 ('884) as both claims add the step of displaying in the table the values and suits corresponding to the data.

Claim 8 ('138) is obvious over claim 8 ('884) as both claims add the step of reconstituting at a count or a trigger.

15 Claim 9 ('138) is obvious over claim 9 ('884) as both claims add the step of reconstituting at a count, trigger, or the player prompting.

Claim 10 ('138) is obvious over claim 10 ('884) as both claims add the step of displaying a pay table reconfigured to display only possible outcomes.

20 Claim 11 ('138) is obvious over claim 19 ('884) as storing the data in a data structure arranged in random order is an obvious alternative to having the processor randomly choose the data directly.

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Claim 12 ('138) is obvious over claim 20 ('884) as both claims add the limitation of the processing displaying the constituency of the deck.

Claim 13 ('138) is obvious over claim 21 ('884) as both claims add the limitation of displaying the data after the selection and display of the card.

5 Claim 14 ('138) is obvious over claim 22 ('884) as both claims add the limitation of reconstituting at a predetermined point in the count.

Claim 15 ('138) is obvious over claim 23 ('884) as both claims add the limitation of an input device to prompt the reconstitution of the deck.

10 Claim 16 ('138) is obvious over claim 19 ('884) as it would be obvious to display data that is to be read by the user in a table in order to aid comprehension.

Claim 17 ('138) is obvious over claim 1 ('884) as randomizing the data in the data structure would have been obvious to one of ordinary skill in the art in order to ensure that the desired odds are attained and cheating can not occur.

15 Claim 18 ('138) is obvious over claim 2 ('884) as both claims add the step of displaying the constituency data at the completion of each hand of play.

Claim 19 ('138) is obvious over claim 3 ('884) as both claims add the step of displaying the constituency data after the display of the card.

Claim 20 ('138) is obvious over claim 4 ('884) as both claims add the step of using a counter to determine when to reconstitute the card data.

20 Claim 21 ('138) is obvious over claim 5 ('884) as both claims add the step of allowing the player to prompt for reconstitution.

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Claim 22 ('138) is obvious over claim 6 ('884) as both claims add the step of displaying the constituency data in a table.

Claim 23 ('138) is obvious over claim 7 ('884) as both claims add the step of displaying the value and suit of the cards in the table.

5 Claim 24 ('138) is obvious over claim 8 ('884) as both claims add the step of reconstituting at either a count or a trigger.

Claim 25 ('138) is obvious over claim 9 ('884) as both claims add the step of reconstituting at a counter, trigger, or player prompting.

10 Claim 26 ('138) is obvious over claim 10 ('884) as both claims add the step of displaying a payable that corresponds to only possible winning outcomes.

Claim 27 ('138) is obvious over claims 25 ('884) as storing the data in a data structure arranged in random order is an obvious alternative to having the processor randomly choose the data directly.

15 Claim 28 ('138) is obvious over claim 28 ('884) as both claims add the limitation of the processor displaying the remaining constituency in the deck.

Claim 29 ('138) is obvious over claim 29 ('884) as both claims add the limitation of displaying the constituency of data after display of the card.

20 Claim 30 ('138) is obvious over claim 30 ('884) as both claims add the limitation of a counter to determine when a certain number of cards have been played and to reconstitute once a certain number has been reached.

Claim 31 ('138) is obvious over claim 31 ('884) as both claims add the limitation of providing an input device to prompt reconstitution.

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Claim 32 ('138) is obvious over claim 32 ('884) as both claims add the limitation of displaying the constituency data in a table.

Claim 33 ('138) is obvious over claim 33 ('884) as both claims add the limitation of displaying the value and suits of the card in the constituency table.

5 Claim 34 ('138) is obvious over claim 34 ('884) as both claims add the limitation of using a Joker as a triggering card for reconstitution.

Claim 35 ('138) is obvious over claim 35 ('884) as both claims add the limitation of adding a third condition for limitation wherein a player can input a signal for reconstitution.

10 Claim 36 ('138) is obvious over claim 36 ('884) as both claims add the limitation of displaying a payable that changes based upon winning outcomes eliminated.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

15 ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

20 (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459
25 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.

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2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

5

Claims 1-4, 6-14, 16-20, 22-26, 27-30 and 32-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fuchs (US Patent No. 5,630,753).

Fuchs disclose a method and apparatus for playing a card game wherein a processor
10 selects data symbols from a large number of predetermined in accordance with a randomizing
criteria (Column 1, lines 15-18). Thus the predetermined number of symbols represents a fixed
amount. These symbols from which the processor selects are inherently stored in a data
structure. The player can then place a wager (Column 7, lines 45-51). The player can then play a
series of hands and for each hand of play the symbols are selected from the data structure
15 (Column 1, lines 15-18) and are presented on a display representing an initial holding of at least
cards (FIG 1). It is disclosed that the number of symbols are predetermined (Column 9, lines
23-27), and are selected randomly (Column 1, lines 15-18). Further, it is inherent to the
functionality of the device that the symbols would be stored in a data structure for access. Fuchs
discloses that the symbols are displayed in accordance with a pre-established game plan and are
20 stored in a list (Column 4, lines 45-53). Henceforth, it would be obvious to one of ordinary skill
in the art that the symbols could be accessed randomly from the list data structure, or
alternatively stored in a random order in the list data structure and then accessed serially. Both
are well known methods of randomizing data and absent a showing of criticality would have
been equivalent design choices to one of ordinary skill in the art.

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Fuchs then discloses that the initial hand can be completed by holding cards (Column 6, lines 37-40) and by replacing select cards (Column 3, lines 1-8). If a player chooses to replace the cards, the processor replaces the card with still available game symbols that are the next random card to determine a final outcome (Column 1, lines 36-38).

5 Fuchs also discloses that at the player's request or because of a repeatedly appearing display of new cards, the player can be presented with a display of the initial game symbols available at the start of the game (Column 9, lines 47-51). Upon a hand being played, the display (FIG 5) will be updated to reflect the new inventory of the symbols (Column 9, lines 54-67). The display of the constituency of the deck is in the form of a table (FIG 5) including values.

10 The disclosed embodiment is for slot machine symbols but in the poker embodiment it would be obvious that the display of the symbols would be for the suits and values of the card. The computer will then determine if a player is a winner or loser and issue an award if applicable (Column 10, lines 30-34). Because it is disclosed that the machine will pay out a win as a function of the wins scored by the player, it is inherent that a second data structure would be

15 storing a reference table to reference a win amount with a player combination.

The display is shown upon completion of the hand as it is stated that from game to game the symbols offered to the player would be deducted (Column 9, lines 61-65). It is also possible to display the constituency of the deck data after the selection and display of the card (Column 6, lines 6-36).

20 Fuchs also discloses that it is advantageous to proceed in such a manner that after a certain number of hands and/or after the presentation of a certain symbol, it is possible to reset the entire number of game symbols (Column 3, lines 46-53). Though Fuchs discloses that a

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certain number of hands are used as the determining factor, it would be obvious to one of ordinary skill in the art to use a certain number of symbols as the limiting factor. One would be motivated to do this because the symbols represent the actual inventory, thus provide a better indication of when the count of cards may be getting low. Inherently, a counter is used to
5 determine the number of symbols in order to issue a signal to reconstitute at a certain number. Therefore, after a certain predetermined number of symbols have been presented, or a triggering symbol, the entire stock of symbols s reconstituted into new symbol data for use in the game. Fuchs discloses this predetermined symbol to be the appearance of a joker (Column 3, lines 48-50).

10 Fuchs further discloses a payable that is recalculated from game to game as a function of the possible game symbols to display some or all o the winning combinations (Column 10, lines 30-55). The display of Fuchs differs in principle from the fixed lists of all possible winning combinations that are presented on normal gaming machines because the information offered to the player is dependent on the game symbols actually appearing the in display symbols or on the
15 symbols which have been held over from a previous game. Therefore, the payable reflects only the possible winning outcomes to aid the player with the relevant information they need in the shortest time possible (Column 10, lines 30-58).

Claims 5, 15, 21, and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over
20 Fuchs (US Patent No. 5,630,753) in view of Richardson et al. (US Patent No. 5,042,809).

What Fuchs discloses, teaches, and/or suggests has been discussed above and is incorporated herein.

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Fuchs discloses reconstituting the inventory when a certain number of symbols have been played or when a certain triggering symbol appears. However, Fuchs does not disclose allowing the player to call for a reconstitution.

Richardson discloses a game where a fixed number of predetermined chances are also
5 used in the form of pull-tabs (Abstract). The number of winning pull-tabs left and the major prizes left are displayed to the player (FIG 3). Richardson provides the player with an input device that can be used to call for a new deal at any time after playing one hand (Abstract, Column 3, lines 66-67). Richardson discloses that it is advantageous to allow for a new deal after all the winning chances have been redeemed or if all the major chances have been
10 redeemed. By incorporating this rule and then allowing a player to reconstitute the winning chances, the player will feel in more control of the machine, as they will be allowed to restore all the winning possibilities at any time and thus be more inclined to continue play as no player would continue play on a machine that clearly indicates no winning chances remain. Therefore, it would have been obvious to one of ordinary skill in the art to incorporate this feature in to the
15 device of Fuchs in order to allow the player to call for a reconstitution. One would be motivated to make this combination to allow the player to feel they have a better shot of winning, thus causing the player to play more on the game. Fuchs discloses that when a player feels his game situation is improved and the prospect of winning greater, the actual or apparent improvement in the player's situation greatly enhances the attractiveness of the machine. Thus by allowing the
20 player the power to reconstitute the inventory, this goal would be achieved.

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Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

5 **US Patent No. 6,533,658:** Database keeps a location status of all cards. The database keeps track of whether a card is in the deck, dealt, or discarded.

US Patent No. 5,967,894: Poker game where odds are dynamically calculated along with the hand and the payable is altered to show possible conditions and impossible conditions.

US Patent No. 6,357,150: Reverse mapping strategy that computes keeps a pool of symbols wherein the symbols are removed from the pool upon use.

10 **US Patent No. 5,882,258:** Card game where the total remaining amount of cards are displayed for the user to determine the number of chances they have left.

US Patent No. 6,299,531: Roulette table that keeps a history of the location where the ball has landed.

15 **US Patent No. 6,062,979:** Gaming system with a card meter to display the card in use and the amount of cards left.

US Patent No. 6,131,906: Blackjack calculator to aid in strategy and counting the number of cards that have been played as well as incorporating the value of the cards indirectly into the calculation.

US Patent No. 6,343,989: Computer that estimates the highest expected value of a blackjack hand and then determines player error from the value.

20 **US Patent No. 6,129,631:** Method and apparatus for generating card improving strategies and optimizing play.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to C. Marks whose telephone number is (703)-305-7497. The examiner can normally be reached on Monday - Friday (7:30AM - 4:00 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, V. Martin-Wallace can be reached on (703)-308-1148. The fax phone numbers for the organization where this application or proceeding is assigned are (703)-872-9302 for regular communications and (703)-872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)-308-1148.

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Cmm
cmm
April 2, 2003



**MICHAEL O'NEILL
PRIMARY EXAMINER**

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